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8 UNITED STATES DISTRICT COURT
9 FOR THE SOUTHERN DISTRICT OF CALIFORNIA
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11 SEQUENOM, INC.,

12 Plaintiff,

13 vs.

14 ARIA DIAGNOSTICS, INC.,

15 Defendant,

16 and

17 ISIS INNOVATION LIMITED,

18 Nominal Defendant.
19

Case No. 12-CV-0189-BEN-BGS

**ORDER GRANTING ARIA
DIAGNOSTICS, INC.'S EX PARTE
MOTION TO STAY PENDING
RESOLUTION OF SEQUENOM'S
MOTION TO DISMISS OR TRANSFER
ARIA'S FIRST-FILED ACTION IN THE
NORTHERN DISTRICT OF
CALIFORNIA, [Doc. No. 13].**

20 Pending before the Court is Defendant Aria Diagnostics, Inc.'s *ex parte* motion to stay this
21 action pending resolution of Plaintiff Sequenom, Inc.'s motion to dismiss or transfer Aria's first-
22 filed action in the Northern District of California.¹ Sequenom filed an opposition and Aria replied.
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24 ¹ On December 19, 2011, Aria filed a complaint for declaratory judgment against
25 Sequenom in the Northern District of California, seeking a declaration that Aria's non-invasive
26 prenatal test did not infringe any claim of U.S. Patent No. 6,258,540 ("the '540 patent"). *See Aria
Diagnostics, Inc. v. Sequenom, Inc.*, Case No. 11-cv-6391-SI (N.D. Cal.). On January 24, 2012,
Sequenom commenced this patent infringement action, alleging that Aria's prenatal test did
infringe the '540 patent, which was licensed exclusively to Sequenom. [*See* Doc. No. 1.]


27 Two more declaratory judgment actions have been commenced against Sequenom in the
28 Northern District of California, seeking a declaration of invalidity and non-infringement as to the
'540 patent. *See Natera v. Sequenom, Inc.*, Case No. 12-cv-132-SI (N.D. Cal. filed Jan. 6, 2012);
Verinata Health, Inc. v. Sequenom, Inc., Case No. 12-cv-865-LB (N.D. Cal. filed Feb. 22, 2012).

1 Having considered the parties' arguments, the Court **GRANTS** the *ex parte* motion to temporarily
 2 stay this second-filed action. *See Kerotest Mfg. Co. v. C-O-Two Fire Equip. Co.*, 342 U.S. 180,
 3 185 (1952) ("If [the alleged infringer] is forehanded, subsequent suits against him by the patentee
 4 can within the trial court's discretion be enjoined pending determination of the declaratory
 5 judgment suit . . ."); *Genentech, Inc. v. Eli Lilly & Co.*, 998 F.2d 931, 937 (Fed. Cir. 1993) ("The
 6 general rule favors the forum of the first-filed action, whether or not it is a declaratory action."
 7 (citation omitted)), *abrogated on other grounds by Wilton v. Seven Falls Co.*, 515 U.S. 277
 8 (1995); *SAES Getters S.p.A. v. Aeronex, Inc.*, 219 F. Supp. 2d 1081, 1089 (S.D. Cal. 2002) ("The
 9 first-filed rule is a comity rule for resolving conflicts of jurisdiction where parallel actions are filed
 10 in different federal district courts. It provides that where substantially identical actions are
 11 proceeding in different courts, the court of the later-filed action should defer to the jurisdiction of
 12 the court of the first-filed action by either dismissing, staying, or transferring the later-filed suit.").

13 Accordingly, this action is **STAYED** pending the resolution of Sequenom's motion to
 14 dismiss or transfer Aria's first-filed action in the Northern District of California. *See Aria*
 15 *Diagnostics*, Case No. 11-cv-6391-SI (N.D. Cal.). Counsel for Aria is **ORDERED** to notify the
 16 Court as soon as there is a determination on Sequenom's motion to dismiss or transfer.

17 **IT IS SO ORDERED.**

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 19 Dated: February 19, 2012

20 
 21 Hon. Roger T. Benitez
 22 United States District Judge
 23

24 On January 24, 2012, Sequenom also commenced a patent infringement action against Natera in
 25 this District. *See Sequenom v. Natera, Inc.*, Case No. 12-cv-184-DMS-MDD (S.D. Cal.).

26 There are currently Sequenom's motions to dismiss or transfer to this District pending in
 27 two of the Northern District actions. *See Aria Diagnostics*, Case No. 11-cv-6391-SI, Doc. No. 13
 28 (March 9, 2012 hearing); *Natera*, Case No. 12-cv-132-SI, Doc. No. 13 (March 30, 2012 hearing).
 On February 23, 2012, following a status conference in one of the other second-filed actions,
 Judge Sabraw ordered the parties to submit a joint motion to stay the case pending a ruling in the
 related Northern District case. *See Sequenom*, Case No. 12-cv-184-DMS-MDD, Doc. No. 10.